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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,601	11/28/2003	Masahiro Motomiya	246009US90	8267
22850	7590	12/29/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SHAFFER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,601	Applicant(s) MOTOMIYA ET AL.	
	Examiner Ricky D. Shafer	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3, 5-9, 12 and 13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2872

1. Applicant's election with traverse of species "2", the mirror housing is positioned in the retracted origin position at the time when doors of the vehicle is unlocked in the reply filed on October 06, 2005 is acknowledged. The traversal would appear to be on the ground(s) that there would be no undue burden to examine the non-elected species along with the elected species. This is not found persuasive because the restriction requirement set forth in the communication mailed on September 07, 2005 is based on the claimed structural differences between the various species and not on their similarities. Continued search and examination of claims to a non-elected species having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected species is not patentably distinct from the elected species.

Please note that 37 CFR 1.141(a) clearly states that more than one species of an invention may be claimed in an application, provided that the application includes an allowable generic (linking) claim to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic (linking) claim.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 10 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Applicant timely traversed the restriction (election) requirement in the reply filed on October 06, 2005.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 5(2), 6(5,2), 7(5,2), 8(5,2) and 12(8,5,2), drawn to an electrically retractable outer mirror for a vehicle comprising a mirror housing, a mirror in the

mirror housing, housing rotating speed variable means for varying a rotating speed of the mirror housing and a housing angle detection/storage means for detecting and storing an angle of the mirror housing (ABD), classified in class 359, subclass 841.

- II. Claims 3, 5(3), 6(5,3), 7(5,3), 8(5,3) and 12(8,5,3), drawn to an electrically retractable outer mirror for a vehicle comprising a mirror housing, a mirror in the mirror housing, housing rotating speed variable means for varying a rotating speed of the mirror housing and a switch input determination circuit, a motor apply voltage adjustment circuit or motor apply current adjustment circuit with or without a housing angle detection/storage means for detecting and storing an angle of the mirror housing (ABC, ABCD), classified in class 359, subclass 841.
- III. Claims 5(1), 6(5,1), 7(5,1) 8(5,1) and 12(8,5,1) drawn to an electrically retractable outer mirror for a vehicle comprising a mirror housing, a mirror in the mirror housing and a housing angle detection/storage means for detecting and storing an angle of the mirror housing (BD), classified in class 359, subclass 843.

Claims 9 and 13 have not been group at this time due to the fact that these claims are improper multiple dependent claims.

4. Claim 1 link(s) inventions I, II and III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are

Art Unit: 2872

advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim 2 link(s) inventions I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 2. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions [I,II] and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

Art Unit: 2872

case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of a housing angle detection/storage means for detecting and storing an angle of the mirror housing, as evidenced by claims 2 and 3. The subcombination has separate utility such as an electrically retractable outer mirror without a housing rotating speed variable means for varying a rotating speed of the mirror housing and/or a switch input determination circuit, a motor apply voltage adjustment circuit or motor apply current adjustment circuit.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions have separate utility such as an electrically retractable outer mirror with the separate details of the other invention. For example, the electrically retractable outer mirror of invention II has separate utility as an electrically retractable outer mirror without a housing angle detection/storage means for detecting and storing an angle of the mirror housing of invention I, as clearly evidenced by claim 3 and the electrically retractable outer mirror of invention I has separate utility as an electrically retractable outer mirror without a switch input determination circuit, a motor apply voltage adjustment circuit or motor apply current adjustment circuit of invention II. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one of Groups would not be required for any of the remaining Groups, as indicated below, restriction for examination purposes as indicated is proper.

The search required for Group II would require a search in class 359, subclass 877 which would not be required for Groups I and III.

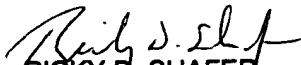
The search required for Group I would require a search in class 359, subclass 872 which would not be required for Group III.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS
December 25, 2005


RICKY D. SHAFER
PATENT EXAMINER
ART UNIT ~~2872~~ 2872